

REMARKS

New proposed claim 35 differs significantly from the prior art in requiring:

1. holding the inner medical element in a curve that is "substantially 90 degrees out of the first plane"
2. holding the inner medical element in that curve "to form a medically usable shape"
3. performing a medical procedure while the curve of the inner medical element is in its substantially 90 degrees out of plane shape.

None of the references show or suggest these features. None hold in a substantially 90 degree out of plane configuration. For example, Sylvanowicz, even given the most liberal interpretation, does not maintain such an extreme out of plane shape. Nor does Sylvanowicz suggest that such an extreme out of plane shape (after being formed and held) can be used in a medical procedure. This claim, therefore, differs from the prior art in that it is directed to shaping (in particular forming this extreme out-of-plane shape) and then using. None of the other references teach this. Of course, D'Amelio et al. teaches avoiding such out-of-plane shapes altogether.

For all these reasons, new proposed claim 35 would be allowable over the art.

Proposed new claims 36-39 depend from proposed claim 35 and would be allowable therewith. Claim 36 and claim 37 further specify that the distal end portion of the inner medical element points toward a target in the human body disposed substantially out of the first plane (claim 36) and that the distal end portion of the catheter tube points substantially at right angles away from the target (claim 37, which depends from claim 36). Sylvanowicz, for example, has an inner medical element whose distal

end portion is co-planar with the distal end portion of the catheter tube (since, as explained in the appeal brief, they both point toward the same target). These claims are allowable for these reasons as well.

Claim 38 further specifies forming the distal end portion of the combination catheter into an up-going shape. None of the references show an out-of-plane shape that is also up-going. Claim 39 further specifies forming the distal end portion of the combination catheter into a down-going shape. Similarly, none of the references show an out-of-plane shape that is also down-going. Inasmuch as claims on applicant's method directed to up-going and down-going catheters are already issued (and thus patentable), the combination of those features with the out-of-plane feature of the present claims is also allowable.

Claim 40 is another independent method claim. It specifies

1. holding the distal end portion of the inner medical element so as to create an out-of-plane shape in the distal end portion of the combination catheter; and;
2. wedging the out-of-plane shaped distal end portion of the combination catheter against a wall in the human body to hold the combination catheter in place.

This feature is described in the parent application as filed and is completely absent from the art. Sylvanowicz, for example, has a portion wedged against the wall of the human body—which portion is clearly in-plane with the distal end portion of the combination catheter. And of course D'Amelio et al. teaches to avoid out-of-plane shapes altogether. Even if it did not, wedging (as required by this claim) would be antithetical to the

purpose of D'Amelio et al.—which requires spinning of the viewing element around in the can.

Claim 40 is allowable for all these reasons.

Claim 41 is similarly allowable over the art. It is a method claim that requires:

1. holding the distal end portion of the inner medical element in a substantially out-of-plane configuration and
2. moving at least one of the catheter tube and the inner medical element (or both) longitudinally while the distal end portion of the inner medical element is in the out-of-plane configuration.

The prior art teaches neither step. Sylvanowicz, even under the most liberal interpretation, does not hold the distal end portion of the inner medical element in a substantially out-of-plane shape. Nor does it teach longitudinally moving the catheter tube or the medical element, or both, while the distal end portion is in this out-of-plane configuration. D'Amelio et al. on the other hand teaches avoiding out-of-plane shapes.

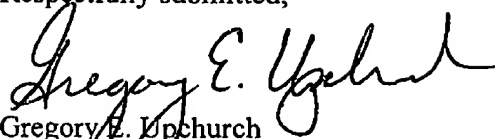
For all these reasons, claim 41 is allowable over the art.

Claims 42 and 43 depend from claim 41 and further recite the up-going and down-going features discussed above. They are allowable for all those reasons.

Applicant believes these claims would avoid the necessity of an appeal in this case and bring this application to a conclusion.

The Office is hereby authorized to charge deposit account #08-3460 for any additional fees required.

Respectfully submitted,



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